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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/445,576 07/17/00 THOGERSEN

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WASHINGTON DC 20004

HM22/0913

EXAMINER

CANELLA, K

ART UNIT

PAPER NUMBER

1642

DATE MAILED:

09/13/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/445,576

Applicant(s)

Thorgersen et al

Examiner

Karen Canella

Art Unit

1642



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 30 days MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-33, 35-39, 47, 48, 51, 52, and 54-67 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 1-33, 35-39, 47, 48, 51, 52, and 54-67 are subject to restriction and/or election requirements.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

Art Unit: 1642

### **DETAILED ACTION**

1. Claims 34, 40-46, 49, 50 and 53 have been canceled. Claims 1-19, 21, 24-28, 30, 31, 35-39, 47, 48, 51, 52 and 54 have been amended. Claims 1-33, 35-39, 47, 48, 51, 52 and 54-67 are pending.

### ***Election/Restrictions***

2. A national stage application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept. Unity of invention is fulfilled only when there is a technical relationship among the inventions involving one or more of the same or corresponding special technical features which define a contribution over the prior art. If there is no special technical feature, if multiple products, processes of manufacture or uses are claimed, the first invention of the category first mentioned in the claims of the application will be considered as the main invention in the claims, see PCT article 17(3) (a) and 1.476 (c), 37 C.F.R. 1.475(d).

The special technical feature of the instant claims is the tetranectin trimerizing structural element. As indicated in the International Preliminary Examination Report of PCT/DK98/00245, certain claims are anticipated by WO 95/31540 and WO 94/18227, and therefore the claimed invention as a whole is not novel. Thus, Unity of Invention is found to be lacking.

3. Because the inventions lack Unity of Invention for the reason(s) set forth above, the inventions are held to be distinct. Therefore, restriction for examination purposes as indicated is proper.

4. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

Art Unit: 1642

Group I, claims 1-18, 25, 28-30, 36, 47, 55-59 and 66, drawn to monomer peptide constructs, compositions, diagnostic agents and kits thereof, and a method of preparing monomer peptide constructs.

Group II, claims 19-24, 26, 27, 60 and 61, drawn to oligomer peptide constructs and methods for preparing dimeric and trimeric peptide constructs.

Group III, claims 31-33, drawn to nucleic acids encoding TTSE, vectors and host cells comprising said nucleic acids.

Group IV, claims 35, 38, 39, 48, 52, 62-65 and 51-in-part, drawn to methods of treating or preventing disease and methods of targeted gene therapy, all methods comprising the administration of a monomer peptide construct. Claim 51 will be examined with this group to the extent that it reads on the administration of a monomer peptide construct.

Group V, claim 51 in part, drawn to methods of targeted gene therapy comprising the administration of oligomer peptide constructs. Claim 51 will be examined with this group to the extent that it reads on the administration of an oligomer peptide construct.

Group VI, claim 54, drawn to method of disease diagnosis comprising contacting a sample with a monomer peptide construct.

Group VII, claim 67, drawn to an improvement in a method for displaying a protein library comprising the use of a monomer peptide construct as a linking agent.

Group VIII, claim 37, drawn to a method of using a monomer peptide construct in the assembly of antibody fragments.

5. Because of the complexity of the claims, telephonic restriction was not attempted.
6. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Art Unit: 1642


7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karen Canella whose telephone number is (703) 308-8362. The examiner can normally be reached on Monday through Friday from 8:30 am to 6:00 pm. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa, can be reached on (703) 308-3995. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Karen A. Canella, Ph.D.

Patent Examiner, Group 1642

August 29, 2001

  
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